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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER L. JOHNSTON

Appeal 2009-004993
Application 10/080,982
Technology Center 3600

Oral Hearing Held: September 14, 2010

Before JENNIFER BAHR, STEFAN STAICOVICI and
KEN B. BARRETT, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Tuesday, September14, 2010, commencing at 1:20 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo, Notary Public.

JUDGE BAHR: Good afternoon, Mr. Newholm.

MR. NEWHOLM: Good afternoon. May it please the board, at issue in this case is whether various claims in the pending application for a triangulated mobile gantry are indefinite under 35 USC 112, second paragraph, and whether all the claims are obvious under 35 USC section 103(a).

I'm going to spend a few minutes on the 112 rejections hopefully mainly as a housekeeping matter but I would like to spend most of my time on the rejections based on obviousness.

Turning first to the rejection on indefiniteness, first the Examiner has some problems with language in claims 1, 13, 14 and 16 through 18 which recite that wherein clause, first, second and third longitudinal lines interconnecting said first, second and third booms form an acute triangle.

It's Appellant's position that that meaning is perfectly clear on its face and made even more so with reference to the underlying disclosure.

I would also like to point out that it's been a frustration over this rejection being raised at this late point in the prosecution. The language at issue was added after interview with the Examiner, I believe after the second office action, and the Examiner examined the case without any objection or problem with that language for another three office actions until finally raising the issue in the first office action after RCE, request for continued examination.

But I think in context, it's perfectly clear what's being claimed. It's a gantry that has three booms supported on the ground and all this limitation is doing is

describing the geometric relationship between those booms. If one were to draw lines connecting those booms, first, second and third lines, it would form an acute triangle.

Now, that precise language is not in the specification. Again, this language was added after the application was filed as a result of the interview with the Examiner. But I think that the concept is certainly understandable in isolation and with reference to the entire application.

If you look, for instance, at figure 2 of the drawings, it clearly shows top plan view. You can see three booms spaced from one another such that lines connecting them would form an acute triangle.

Also, if you look at page 7, lines 17 through 19 of our specification recites a front boom on a lateral to central line of the machine and a left and right rear booms at opposed lateral sides of the line. That necessarily describes a triangle.

Now, it need not necessarily been an acute triangle probably, but I think the acute aspect is certainly supported by the drawings and I think more importantly we're not dealing with a new matter issue here, objection or rejection. We're dealing with a question of definiteness and I think it's perfectly definite.

The Examiner seems confused by the fact that those lines are not expressly shown in the drawings and, in fact, was making reference to the configuration of the overlying support beams, pointing out that those beams form an A frame in the disclosed embodiment.

I agree they do but that's not what's being claimed. We're claiming three booms spaced to define an acute triangle and then beams supported on those booms.

Any questions on that issue?

JUDGE BAHR: No.

MR. NEWHOLM: I'll spend just a very brief time on the Examiner's rejection for the various claims for reciting the rigging contending that the Examiner is not clear as to whether it's an apparatus claim or a method claim.

Again, this rejection was raised for the first time in the first office action after RCE, after the Examiner had found no problems with that exact language at least twice before that.

I'm, frankly, very surprised at this rejection. I think it's very clear from underlying case law and office policy that this sort of functional language is absolutely fine in a claim and there's nothing per se indefinite about it. It certainly does not somehow create confusion as to whether it's an apparatus claim or a method claim.

It's functional limitations within method claims perfectly acceptable pursuant to --

JUDGE BARRETT: I don't think the Examiner was necessarily taking issue with functional language being acceptable. I think the Examiner's position was it's not clear that this is indeed functional language.

MR. NEWHOLM: The Examiner stated in his Examiner's answer that it was unclear as to whether they were apparatus claims or method claims, if I recall correctly. I can find that citation for you.

JUDGE BARRETT: That's fine. My impression was the Examiner was talking about the limitation specifically. It looked like it may be method-type limitation, specifically the wording in claim one, the rigging lifting the load from the ground upon subsequent extension of the booms.

MR. NEWHOLM: Yes. It's reciting the intended function of the rigging which I think is entirely acceptable pursuant to MPEP 2173.05 -- pardon me. Pursuant to MPEP 2173.05(g) and In re Schreiber.

I think the proper interpretation for the Examiner there is to consider that functional language, even method language, if you will, and pursuant to In re Schreiber and 2173.05(g) determine whether or not the cited prior art is capable of operating in the manner claimed.

If, in fact, the Examiner determined that it is capable of operating in the manner claimed, then the Examiner could sustain or maintain a prior art rejection based on it and it would be our burden to prove the prior art is incapable of operating in that manner, again, pursuant to In re Schreiber and that section of the MPEP. Does that answer your question?

JUDGE BARRETT: I think so. I think I understand your position.

MR. NEWHOLM: Finally, there was in claim 20 we had, frankly, a typo that again was not discovered by the Examiner until very late in the game, in which we had lack of antecedents for the term "the vehicle" when earlier in the claim or the claim from which it depended recited a gantry.

This is the sort of thing that ordinarily I would never take to appeal. We, in fact, tried to take care of it via an amendment filed simultaneously with the Appeal Brief. That amendment was denied entry on the grounds that it did not simply cancel claims.

I will say I think it's clear that something that lacks that antecedent basis does not necessarily render a claim indefinite. You have to look at it in the underlying context.

Here it's clear that "vehicle" is being used interchangeably with gantry. I will

say on the record if the board were to disagree, that's the sort of thing we will happily amend to clarify the claim to maximize precision.

JUDGE BARRETT: Did you make that argument in the Briefs, that it was clear on its face? Did you address the substance of the rejection?

MR. NEWHOLM: I, frankly, don't recall what was said in our Brief at this point, which actually brings me -- moving into the prior art rejections to a point, I have several things to say regarding the prior art rejections that might not be expressly recited in our Brief, and that is because the Examiner obtained translations of the three foreign -- well, more than three but today I'll discuss three foreign language references that relied upon in the rejection at the time of the issuance of the Examiner's answer and based several of his arguments on those translations.

We did not have access to those translations prior to that and our attempt to respond to it via Reply Brief were denied. So some of the statements I have to say are based on amendments that have come to my attention or, I should say, language that has come to my attention only since the Examiner's answer. And I will point out that the Examiner, securing that translation so late in the game, has been found by the board to be at least in violation of the spirit of MPEP section 702.02 because it does and can and did in this case deny the Appellant the opportunity to fully respond to the -- address the prior art being used by the Examiner.

JUDGE BAHR: Did you obtain that translation?

MR. NEWHOLM: No, the Examiner did. We did not obtain translations.

JUDGE BAHR: You chose not to, then?

MR. NEWHOLM: Correct. The Examiner is relying primarily on drawings

until the end, until the Examiner's answer at one -- once the Examiner had -- let me back up.

The Examiner was relying on drawings and abstracts. There were English language abstracts in some of the references. In the answer, the Examiner then relied upon the body of the references.

JUDGE BAHR: You said you tried to respond to those and your Reply Brief was denied entry?

MR. NEWHOLM: Yes.

JUDGE BARRETT: You had those translations before your Reply Brief, right?

MR. NEWHOLM: Yes. Frankly, I don't recall what was said in the Reply Brief at this point. I haven't gone back and looked at it again because it was denied entry, so I knew it was not part of this record.

Okay. Turning now to the substance -- unless there's any other questions regarding the 112 rejections. Okay. Turning now to the substance of the rejections based on prior art. I am going to limit my comments today regarding the rejection -- I'll call it the primary rejection based on the combination of the Soviet Union patent, the French 460 patent and the French 502 patent or Gonzales. The Examiner relied on those.

The invention as recited in these various claims and rejected in these references relates to a mobile gantry crane used to lift heavy objects which, pursuant to the specification, I believe, on the order of 20 to 200 tons, with the key elements being that instead of being traditional four-wheeled structures or sometimes four-track structures, we have three independently mounted booms that are then interconnected to one another by lift beams.

Those three booms provide a much stabler support surface than is provided by a traditional four-point mount structure.

The specification describes a four-point structure as being akin to a chair rocking on the floor. Whereas, this, what the client calls delta lift, the three-point structure is much more stable, more akin to a tripod for mounting a camera, say. That stability feature, I think, is important because it's not addressed anywhere in the prior art.

Now, in addition to that, all the claims recite that each of those booms be independently rotatable relative to the ground for steering purposes and that depends on the claim, but all the claims require that at least one of the lift beams connecting these three booms be extendable to vary the footprint, if you will, of the machine.

The benefits of that in addition to -- versatility which the Examiner does hit at very hard, is it greatly increases maneuverability. As mentioned in the background of the application, the goal of this -- primary goal of this invention was to permit these big, mobile cranes to be able to squeeze through doorways or other tight places in buildings and still configure itself to lift the load and carry a load.

The Examiner relies as a primary reference the Soviet Union 434 patent. That is relevant, I think, more from an appearance as anything else. Most notably it is a rail-mounted gantry. Not a ground-mounted gantry.

So the issue is of stability and maneuverability that are so important to us are completely irrelevant to that machine. Since it's on rails, the rails provide the stability, doesn't have to worry about rocking or having a badly distributed load at least as much. And of course maneuverability, its travel path is always determined by the rails.

One moment, please. Now, it is unusual the Soviet 434 crane in that it does not have traditional four booms at the four corners of the gantry. It is mounted on the ground at four support points via the wheels and the rails. So a big difference from us right there. But instead of having the traditional four booms, it's got two booms at one side and arguably one or two at the other side but a single support point at the top.

So instead of having, if you will, a rectangular support structure at the top, it is a triangular structure, one of which forms the major lift beam and the other of which essentially provides reinforcement for that lift beam.

Now, even the translation of this reference, in my view at least, is not entirely clear. So feel free to jump in if you disagree. But as I understand it, what they were trying to do with this reference -- this invention is to be able to configure rails relative to a building site so that one edge of the crane actually is outside of the -- what was the term that they used here -- erection spacing, outside of the erection spacing and the other one is within it.

And then by angling the main support beam backwards relative to the rail that's inside the erection spacing, they can move the load closer to the work area and get it right in there as opposed to having it being limited further away from the key work area. At least that's my interpretation of the reference.

That of course is not at all dealing with any of the problems we're dealing with, with our invention. So the resulting device has several key differentiators from the invention. It lacks the three independent ground-supported booms, it lacks the ability to independently move or rotate each of the booms relative to the ground, and it lacks any ability to extend or retract the various beams.

Now, with respect to the first two issues, that meaning the ground-supported booms and the rotation of the booms relative to the ground, the Examiner relies on the French 460 patent. Now, before I get into the details of that patent, I would like to say whenever we start to talk about rail-mounting machines and ground-mounting machines, we're already talking about different fields of endeavor.

To say it would be obvious to replace rail-mounted booms or ground-mounted booms is akin, in my view, to saying it would be obvious to take a train and configure it to drive along the road. The train is configured to drive along the tracks for a reason. And absent some other good reason, you don't -- there would be no reason to configure the train to drive along the road.

So in my view to somehow replace the booms and the, I think they are called, trolleys of the Soviet 434 patent with ground-supported rotatable booms really would provide no benefit whatsoever to that system because it is clearly designed to be on that fixed path and to move things into the erection area. Again, remember, the whole reason that they have that primary lift boom at an angle is to define the relationship that they want with respect to the erection zone, I believe it's called.

If you don't have a fixed path going into that, there really would be no reason to have the specific configuration they are claiming.

JUDGE BARRETT: You say the rail versus road-mounted are different fields of endeavor. Wouldn't a person of ordinary skill in the art of gantry engineering be familiar with both of those arts?

MR. NEWHOLM: I'm not necessarily saying it's not analogous art. Different fields of endeavor, I still think they are. It's like oil extraction versus oil storage in the In re Clay case. Those familiar with the industry

would know both fields because they are related but they have very different applications and functionality.

Now, as far as the problems being addressed, the other half of the non-analogous art test, I would say that the problems being addressed by the French 460 patent aren't applicable to the Soviet Union 434 patent because of the fact that there would be no reason, again, to provide maneuverability or steerability to a rail-mounted system. In fact, it would just unnecessarily complicate it.

And in the recently promulgated PTO guidelines on nonobviousness citing a Supreme Court case which slips my mind right now, the PTO has said that that is, in fact, an indicia of non-obviousness when there is an unnecessary complication to the primary reference to no discernible benefit.

Now, with respect to the French 460 patent, I need, I believe, to point out an error in the Examiner's answer in which he states that figure 5 shows that machine as being supported on rails. So in fact, he seems to be making the argument that the French 460 patent teaches the interchangeability of rail-mounted gantries and ground-mounted gantries.

That is not the case. The translation of the 460 patent, as provided by the Examiner, states that figure 5 shows the machine is rolling along, quote, a transverse pathway, end quote. That's page 9, last paragraph.

Backing up a little bit, the French 460 patent is designed to permit -- it's designed for use in cemeteries to permit the transport of vaults and crypts around the cemeteries.

It does have something in common with our invention from the broadest scope meaning maneuverability is important to it. And it does address some of the maneuverability aspects of our invention but it doesn't suggest, contrary to the

Examiner's assertion, that its concepts are applicable to rail-mounted machines. Again, I think apples to oranges.

Nor could I find any reference in the translation of the 460 patent to the stability issue that we are addressing. It is, in fact, a three-wheeled structure that is -- with three independently mounted booms. So I suppose one could say the stability issue is inherent but it's still good law, even though it's pre-KSR law, that inherency cannot be relied upon as an indicator of obviousness when making a rejection based on prior art. Any questions about the French 460 patent?

Okay. The last aspect of the invention that is not disclosed by the Soviet Union 434 patent is the ability to increase or decrease the length of at least one of the beams to, again, that's not used in the claims but to effectively alter the footprint of the machine, to vary the spacing between the booms.

The Examiner relies alternatively on the French 502 patent and the Gonzales patent. Now, the French 502 patent I think, frankly, is of little or no help to the Examiner. It is simply a rail-mounted gantry with a hoist that has a crossbeam that is of adjustable length for reasons that is unstated.

The Examiner stated earlier in the rejections that it was to accommodate tracks of different widths which seemed to make sense to us, frankly, but he backed away from that in the Examiner's answer when there was no language in the French 502 patent to support it.

In any event, if, in fact, the reason to have that beam adjustable is, in fact, to accommodate tracks of different widths, different rail spacings, there would be no reason to apply that concept to a ground-mounted gantry because we're not on rails at that point.

That brings us finally to Gonzales, which is a carpet hoist, which again, I think is a different field of endeavor but does address some of the same problems that gantries typically address.

This is a fairly lightweight machine that is pushed around by hand that is designed to straddle a carpet, hoist it up -- carpet roll, and then move it to a different location. I think it is relevant to the extent that the Examiner says it is, in fact, laterally adjustable to accommodate carpet rolls of different sizes. But again, I don't see how that's applicable to the Soviet Union 434 patent when it's on a fixed-rail system and there's no indication of any need or desire to adjust it in any manner to accommodate anything. Its footprint is fixed by the rails on which it is mounted.

Now, with respect to those last two patents I would like to draw your attention to claims 7 and 16 and method claim 18 which recite a specific -- one of those booms being extendable. And that -- pardon me. Beams being extendable. That would be the beam connecting the second and third booms. These claims are essentially reciting the ability to open and close like a scissors. And it's disclosed in our specification what that permits the machine to do is to, again, squeeze through a doorway and then open up to straddle a load and lift the load.

That particular ability or anything remotely suggesting the same problem is not discussed anywhere in any of the references cited by the Examiner.

If you look at the Soviet Union 434 patent, to achieve that effect, what essentially would have to -- I forget which numbers are used, but vary the spacing between the horizontal beam located above the outboard rail. And I see nothing to be gained by that within the realms of what the 434 patent is trying to accomplish. It seems there would be nothing short of impermissible

hindsight reconstruction that would lead one to make that modification to the Soviet Union 434 patent.

Finally, then, just a quick word on the method claims. The Examiner in Examiner's answer basically said the same as the apparatus claims. So I'm not going to -- he didn't spend any time on it.

I would like to point out from a procedural standpoint that that really is not quite true. To the extent that the functional language that the examiner could just say is being capable of performing in the apparatus claims, hence putting the burden on us needs to be more expressly disclosed for the method claims -- for it to be relevant to the method claims.

Now, in the present case that is significant with respect to, for instance, the recitation of the method claims of raising the vertical booms or the booms vertically to lift the load. That particular concept is not discussed in any of the references. And, in fact, I think only the 460 patent could arguably be considered capable of doing it and instead uses a hydraulically-operated hoist to raise and lift the load.

Also with respect to claim 18 again, that's where we expressly recite a method form, the changing of the distance between the second and third boom to straddle the load which, again, is not remotely suggested in any of the references cited by the Examiner.

Now, of course there's other references relied upon for various other claims. Suffice it to say I don't believe any of those references cure the deficiencies of the primary references relied upon for the rejection of these broader claims.

Any questions?

JUDGE BARRETT: No, I don't believe so.

MR. NEWHOLM: Thank you very much for your time.

Whereupon, the proceedings at 1:46 p.m., were concluded.